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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,804	05/11/2001	Takao Kasai	0445-0299P	5485

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EXAMINER

STEPHENS, JACQUELINE F

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 01/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/852,804

Applicant(s)

KASAI ET AL.

Examiner

Jacqueline F Stephens

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/24/02, 10/11/02.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 9/24/02 and 10/11/02 have been fully considered but they are not persuasive. Applicant argues Paul does not teach the expedient of an agent having a skin-care effect and having substantially no decomposing action on the superabsorbent polymer. However, Paul teaches an absorbent article comprising an agent having a skin-care effect and the absorbent article has a superabsorbent polymer with a water absorption capacity within the claimed range of the water absorption capacity of dependent claim 4. Therefore, it is reasonable to assume the skin care agent does not affect the water absorption capacity of the superabsorbent polymer, and furthermore, has substantially no decomposing action on the superabsorbent polymer.

It is noted in the response filed 10/11/02 that applicant has indicated the Paul invention produces "a disadvantageous effect" on a superabsorbent polymer. However, the affidavit does not give specific comparative results between the present invention and the prior art. Additionally, with respect to applicants' mention of the test results, applicant is invited to provide proof of such results in an affidavit under 37 CFR 1.132 for further consideration.

2. Applicant's arguments with respect to claims 10 and 11 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claims 1-7, 9, 12, and 13, as best understood by the examiner, are rejected under 35 U.S.C. 102(e) as being anticipated by Paul et al. (USPN 6217890 B1).

Regarding claims 1, 4, 12, and 13, Paul discloses an absorbent article comprising a liquid-permeable top layer 22, a liquid-impermeable leak-proof layer 20, and an absorbent layer containing a superabsorbent polymer (Abstract and col. 24, lines 17-32) between the top layer and the leak proof layer (col. 10, lines 29-49). Paul discloses an agent having a skin care effect that is activated on contact with moisture (col. 23, lines 66 through col. 24, lines 16). Paul further discloses the superabsorbent polymer has a water absorption within the claimed range (col. 24, lines 57-62).

Therefore, it is reasonable to assume the skin care agent does not affect the water absorption capacity of the superabsorbent polymer, and furthermore, has substantially no decomposing action on the superabsorbent polymer. Paul discloses the agent

contains a water-soluble viscosity enhancer (thickener) (col. 13, lines 55-64 and col. 15, lines 7-21).

Regarding claim 2, Paul discloses the agent is fixed on a skin-contacting surface of the article (col. 17, lines 41-45).

Regarding claim 3, Paul discloses the agent comprises a water-soluble or water-dispersible plant extract (col. 20, lines 51-65).

Regarding claims 5-7, Paul discloses the absorbent article comprises a liquid-retentive absorbent layer, a liquid-impermeable leak-proof layer, and an agent having an effect on the skin of a wearer on the skin-contacting surface of the article (Abstract, col 17, lines 41-45). Paul discloses the agent contains a water-soluble viscosity enhancer (thickener) (col. 13, lines 55-64 and col. 15, lines 7-21). Claim 7, is a product-by-process claim, which is limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113.

Regarding claim 9, Paul discloses the agent has a dissolving temperature of 30-100°C, which includes the claimed range of 40-100°C (col. 16, lines 53-61).

6. Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Roe et al. (USPN 5648083). Roe discloses a skin-care agent-containing fiber comprising fiber and an effective amount of a skin-care agent containing substantially no water fixed on the fiber in a state ready to be released on contact with moisture (col. 3, lines 4-28).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Regarding claims 11 and 14, Roe discloses the present invention substantially as claimed. However, Roe does not specifically disclose the skin-care agent is fixed together with a textile oil and 1,3-butylene glycol. Blieszner discloses a skin care agent comprising butylenes for the benefit of providing a higher level of protection against the growth of microorganisms (col. 7, line 61 through col. 8, line 9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the skin-care agent of Roe to include butylene glycol for the benefits taught in Blieszner.

Roe/Blieszner disclose the skin-care agent is fixed on the fiber by applying a mixture of the skin-care agent and textile oil or 1,3 butylene glycol to the surface of the fiber followed by drying (col. 10, line 47 through col. 18, line 67 and col. 20, lines 13-17)

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Paul in view of Yanaki et al. (USPN 5538728). Paul discloses the present invention substantially as claimed. However, Paul fails to disclose the water-soluble thickener comprises the claimed material. Yanaki discloses polysaccharide used as a thickener in a skin care composition (col. 3, lines 19-25 and col. 4, lines 11-14, and col. 8, lines

15-44). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate polysaccharide in the agent of Paul. Doing so would provide a water-soluble thickener that gives enhanced viscosity without providing a sticky feeling as taught by Yanaki.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F Stephens whose telephone number is (703) 308-8320. The examiner can normally be reached on Monday-Friday 9:00-5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (703)308-1957. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 306-4520 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Jacqueline F Stephens
Examiner
Art Unit 3761



DENNIS RUHL
PRIMARY EXAMINER

December 29, 2002